

**REMARKS**

Claims 1-3, 5-10, and 12-27 are currently pending in this application. Claims 16-24 are withdrawn from consideration due to a previous Restriction Requirement. As such, claims 1-3, 5-10, 12-15 and 25-27 are presently under consideration.

By this amendment, claims 1, 8 and 26 are amended, and a new Abstract is attached herewith.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

**The Specification Objection is Obviated**

The Examiner objects to the Abstract because the abstract uses the legal phraseology "means." This objection is respectfully traversed.

Applicant respectfully submits that the attached replacement Abstract obviates the above-noted objection.

Accordingly, withdrawal of the objection to the Abstract is respectfully requested.

**Allowable Subject Matter**

Applicant gratefully acknowledges the Examiner's indication of allowable subject matter in claims 25-27 over the art of record. However, Applicant respectfully submits that all of the non-withdrawn claims 1-15 and 25-27 are allowable for at least the reasons set forth below.

**The Claim Objections Are Obviated**

The Office Action objects to claims 8-14 and 26 for minor informalities contained therein. This objection is respectfully traversed.

Applicant respectfully submits that the amendment to claims 8 and 26 obviates the objection of the claims.

In particular, claims 8 and 26 are amended per the Examiner's suggestions. (see page 3 of Office Action).

Accordingly, withdrawal of the objection to claims 8-14 and 26 is respectfully solicited.

### **The Claims Define Patentable Subject Matter**

The Office Action rejects:

Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2002/0140825 A1 to Terashita (hereafter) in view of U.S. Patent No. 6,795,212 to Ichikawa (hereafter Ichikawa).

This rejection is respectfully traversed.

**First of all**, applicant respectfully submits that Ichikawa fails to be proper prior art.

For example, according to MPEP §706.02(l)(1), subject matter which was prior art under former 35 U.S.C. 103 *via* 35 U.S.C. 102(e) is now ***disqualified as prior art*** (emphasis added) against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Applicant respectfully advises the Examiner that the present application and the Ichikawa reference are owned by the same person or subject to an obligation of assignment to the same person.

Evidence of such common ownership is shown in the Assignment papers filed on August 21, 2001 in the present application, depicting "Fuji Photo Film Co., Ltd." as the common owner between the present application and the cited Ichikawa (USP 6,795,212) reference.

In other words, Application 09/842,908 and Patent 6,795,212 were, at the time the invention of Application 09/842,908 was made, both owned by Fuji Photo Film Co., Ltd..

Accordingly, applicant respectfully submits that the cited reference, USP 6,795,212, used for the 103(a) rejection in the Office Action is now disqualified as prior art against the claimed invention.

Applicant further respectfully submits that US Patent Publication 2002/0140825 to Terashita fails to make up for the disqualification of USP 6,795,212. As such, applicant respectfully submits that claims 1-15 are allowable, for at least the reasons set forth above, over the cited references.

**Secondly**, even if USP 6,795,212 (Ichikawa) was not disqualified (although it is), applicant respectfully submits that the combination of Ichikawa in view of Terashita fails to teach or suggest each and every feature as set forth in the claimed invention, for at least the reasons set forth below:

Applicant respectfully submits that the cited art, specifically Terashita, fails to teach or suggest a default model tone characteristic profile being used in the case where information indicating the model of the digital camera is not available.

For example, in the present invention, in the case where the information indicating the model of the digital camera is not available, the model tone characteristic of the digital camera can be corrected by using a default model tone characteristic profile. The case where "the information indicating the model of the digital camera is not available" refers to a situation in which the image data obtained by the digital camera do not accompany the camera model information and the camera model information is not input manually. Alternatively, the case refers to a situation in which the model tone characteristic profile corresponding to the model of the digital camera is not available. As the default model tone characteristic profile, a tone characteristic profile that is most likely to be adopted by a digital camera is preferably used.

Furthermore, in the present invention, the "model tone characteristic profile" refers to data that are used for generating data to correct the tone characteristic of the digital camera of the model. The model tone characteristic profile may be data whose input signal is an actual signal of a subject (that is, a signal corresponding to the case of  $\gamma = 1$  for the subject) and whose

output signal is a signal obtained by photographing the subject with the digital camera and thus having the model tone characteristic of the digital camera. By performing calculation using the data, the actual signal of the subject, that is, a signal having a tone characteristic not depending on the digital camera and not affected by the tone characteristic of the digital camera can be obtained from the signal obtained by photographing the subject with the digital camera.

In contrast with the present invention, Terashita merely discloses that in cases where new camera kind information C, which has not been recorded in the camera classification recording means 8, is inputted, the new camera kind information C and the corresponding image processing conditions may be registered automatically in the camera classification recording means 8 (see Terashita, paragraph [0038]). In other words, Terashita merely discloses that a new camera kind information C can be inputted. However, Terashita fails to disclose that a default model tone characteristic profile is being used when the model of the digital camera is not available.

As such, applicant respectfully submits that Terashita fails to make up for the deficiencies found in the disqualified Ichikawa.

Applicant respectfully submits that neither Ichikawa nor Terashita, taken singularly or in combination, (assuming these teachings may be combined, which applicant does not admit) teach or suggest a default model tone characteristic profile being used where information indicating the model of the digital camera is not available.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the combination of cited references fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claims 1, 8 and 15 are allowable over the combination of Ichikawa and Terashita for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-15 under 35 U.S.C. §103(a) is respectfully requested.

### Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

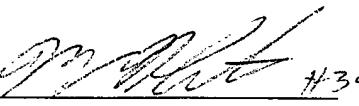
Application No. 09/842,908  
Amendment dated December 21, 2005  
Reply to Office Action of August 25, 2005

Docket No.: 2091-0240P  
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

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Attachment: Abstract of the Disclosure